

## REMARKS

Prior to entry of this amendment, Claims 1-32 were pending in this application, with Claims 1-12 and 24-32 withdrawn from consideration. No claims are added or canceled. Hence, Claims 1-32 are presently pending in this application, with Claims 13-23 currently under examination.

## ELECTION/RESTRICTION

### Introduction

The restriction requirement set forth in the Office Action alleges distinct inventions related as a combination and subcombination, as follows: (I) a first grouping consisting of Claims 27-29; and (II) a second grouping consisting of five species, (a) Claims 1-10, (b) Claims 11-12, (c) Claims 13-23, (d) Claims 24-26, and (e) Claims 30-32. Applicant traverses these restriction requirements and requests reconsideration and modification thereof under 37 CFR 1.143, based on an alternative grouping of the claims proposed below. In addition, Applicant makes a provisional election based on the restriction requirement of record.

### Clarification of Oral Election

Paragraph 6 of the Office Action refers to a July 10, 2003 telephone call to Applicant's representative, in which a request was made for an oral election to a restriction requirement. The Office Action states that Claims 13-23 were elected with traverse. However, this is an inaccurate rendition of the conversation held during the referenced call. Apparently, there was a misunderstanding as to the composition of the oral restriction requirement, as well as to the responsive oral election. Applicant's representative's records of the conversation include the following.

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First, the examiner alleged that there were two claim groupings from which one grouping should be elected. It was alleged that Claims 1-12, 24-26, 27-29 and 30-32 recite a first invention having subject matter related to “network topology” and that Claims 13-23 recite a second invention having subject matter related to “reading preprocessing information”, etc. Second, Applicant’s representative orally elected the claims grouping consisting of Claims 1-12 and 24-32. Hence, not only did the alleged claim groupings change from that stated in the telephone conversation, but the oral election was misunderstood and, unfortunately, Applicant did not receive the benefit of examination of the orally elected claims. Therefore, Applicant traverses the characterization of the oral restriction requirement and the oral election, as described in the Office Action.

#### Provisional Election

Applicant **provisionally elects** for prosecution on the merits, under 37 CFR 1.143, **Claims 13-23**, represented as species II(c).

#### Request for Reconsideration of Restriction Requirement under 37 CFR 1.143

The restriction requirement of record is considered improper for reasons presented below. Reconsideration and modification of the restriction requirement is hereby respectfully requested, under 37 CFR 1.143.

Modification of the restriction requirement to reflect the original groupings that were characterized in the above-referenced oral restriction requirement is requested. Therefore, based on the remarks presented below, a proposed grouping of the claims for the restriction requirement is as follows:

1<sup>st</sup> Grouping: Claims 1-12 and 24-32, with no genus/species classification;

2<sup>nd</sup> Grouping: Claims 13-23.

The Office Action appears to have given an inordinate amount of emphasis to the claim preambles rather than to the body of the claim, in evaluating the claims for the restriction requirement, as evidenced by the requirement as set forth in paragraph 1 of the Office Action. Consequently, an improper grouping results. Analysis of the body of the claims shows the following:

Claims 24-26 recite a computer-readable medium carrying instructions that cause processors to perform steps that correspond with Claims 1, 3 and 4, respectively;

Claims 27-29 recite a computer system having processors configured for performing steps that correspond with Claims 1, 3 and 4, respectively; and

Claims 30-32 recite an apparatus having means for performing steps that correspond with Claims 1, 3 and 4, respectively.

Therefore, the **subject matter of Claims 27-29** (Grouping I) is **not distinct as claimed** from the **subject matter of Claims 1, 3 and 4** because the “combination” computer systems of Claims 27-29 require the particulars of the “subcombination” method steps of Claims 1, 3 and 4, respectively, to show patentability. Hence, the requirements described in MPEP 806.05(c) are not met and the claimed subject matter is not shown to be distinct.

Furthermore, paragraphs 1 and 3 of the Office Action allege that Claims 1-10, 11-12, 13-23, 24-26 and 30-32 are patentably distinct species. Applicant traverses this restriction requirement.

As discussed above, Claims 24-26, 27-29 and 30-32 recite variants of the method of Claims 1, 3 and 4, respectively, claimed in different statutory or otherwise legally

viable and recognized categories. Therefore, Claims 24-26, 27-29 and 30-32 are not patentably distinct from Claims 1, 3 and 4 but are obvious variants thereof.

Furthermore, Claims 1, 3 and 4 are claims to a process linking various forms of a product; namely, a computer-readable medium, computer system and apparatus recited in Claims 24-26, 27-29 and 30-32, respectively. Hence, Claims 1, 3, 4, 24-26, 27-29 and 30-32 must be examined together, if elected.

Claims 11 and 12 are not independent from Claims 1-4 but are different embodiments of the same invention. Claims 1-4 are directed to methods for “automatically generating a network **replication topology** for use by a **directory service**” and Claims 11 and 12 are directed to methods for “automatically populating a **directory service** with a **replication topology**.” Applicants are allowed to claim various embodiments of an invention in different combinations that are described in the specification.

For the foregoing reasons, withdrawal of the species-type restriction requirement with respect to Claims 1-10, 24-26, 27-29 and 30-32 is requested.

Election Based on Proposed Modified Restriction Requirement

If the restriction requirement is reconsidered and modified as requested above, Applicant **elects Claims 13-23** for prosecution on the merits.

REJECTIONS BASED ON PRIOR ART

Declaration under 37 C.F.R. §1.131

Filed herewith by Applicants is a Declaration under 37 C.F.R. §1.131 (“the Declaration”). The Declaration is annexed with: (A) Exhibit 1, a true and correct Ser. No. 09/886,851—Conley—GAU 2171 (E. Leroux)  
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redacted copy of the contents of an electronic mail from Robert Allen, which includes output from a functioning version of a computer program entitled “repl-gen”, which embodies the inventive features described and claimed in the application, the true date of which is prior to October 2, 2000; and (B) Exhibit 2, a true and correct redacted copy of the contents of an electronic mail from Alan Conley, which describes functionality for managing Active Directory replication topology, which embodies the subject invention described and claimed in the application, the true date of which is prior to October 2, 2000. This document includes descriptions of processing router configuration files and pre-processing information, and an extensive textual description of an algorithm that is embodied in the “repl-gen” program.

Exhibits 1 and 2 are submitted as probative of a reduction to practice of the invention prior to October 2, 2000, which is the date of provisional patent application 60/237,211 to which the *Kaan* reference claims priority. Hence, the present invention antedates the *Kaan* reference. Therefore, the *Kaan* reference should be removed from, and not relied upon for, any grounds for rejection of the present claims.

Rejection under 35 U.S.C. §102(e)

The Office Action rejected Claim 13 under 35 U.S.C. §102(e) as allegedly anticipated by Kaan et al. (“*Kaan*”; U.S. Patent Application Publication No. 2002/0065941). The rejection of this claim is traversed.

*Kaan* in no way teaches, suggests or motivates the features that are recited in Claim 13. The citation of *Kaan* that allegedly anticipates Claim 13 refers to a system for managing a network, and does not even remotely teach, either directly, implicitly or inherently, the **method for automatically generating network site and site link**

information from a router configuration file for use in a directory service that is recited in Claim 13. Therefore, it cannot and does not anticipate Claim 13, and the remainder of the cited references do not cure this deficiency of *Kaan*.

Furthermore, in view of the Declaration described above, it is respectfully requested that *Kaan* be removed as a prior art reference on which the rejection of Claim 13 relies. Since the remaining references of record do not teach, motivate or suggest the features of Claim 13, it is not anticipated by any of the references of record. Therefore, withdrawal of the rejection of Claim 13 is kindly requested.

Rejection under 35 U.S.C. §103(a)

The Office Action rejected the following claim groupings under 35 U.S.C. §103(a) as allegedly unpatentable over the respective cited references:

- (A) Claim 13 over *Kaan*;
- (B) Claims 15-17, 20 and 23 over *Kaan* in view of Ecklund (“*Ecklund*”; U.S. Patent No. 4,853,843);
- (C) Claim 18 over *Kaan* in view of Logan et al. (“*Logan*”; U.S. Patent No. 5,968,121);
- (D) Claim 19 over *Kaan* and *Logan* in further view of Chou (“*Chou*”; U.S. Patent No. 5,850,526);
- (E) Claim 21 over *Kaan* and *Logan* in further view of Choudhry (“*Choudhry*”; U.S. Patent No. 6,442,602); and
- (F) Claim 22 over *Kaan* and *Logan* in further view of Shobatake (“*Shobatake*”; U.S. Patent No. 5,872,786).

The foregoing rejections are traversed.

In view of the Declaration described above, it is respectfully requested that *Kaan* be removed as a prior art reference on which the rejections of Claims 14-23 rely. The remaining references of record do not teach, motivate or suggest the features of Claims 14-23 that were allegedly disclosed by *Kaan*. Nor do the remaining references teach, motivate or suggest the features for which they are respectively relied on. Hence, Claims 14-23 are not made obvious by the references of record, either independently or in combinations. Therefore, withdrawal of the rejection of Claims 14-23 is kindly requested.

#### IN THE DRAWINGS

It is noted that the Office Action Summary indicated acceptance of the drawings as originally filed.

## CONCLUSION

For at least the reasons indicated above, Applicants submit that all of the pending claims currently under consideration (13-23) present patentable subject matter over the references of record, and are in condition for allowance. Therefore, Applicants respectfully request that a timely Notice of Allowance be issued in this case. If the Examiner has questions regarding this case, the Examiner is invited to contact Applicant's undersigned representative.

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortages in fees due in connection with the filing of this paper, including extension of time fees, or credit any overages to Deposit Account No. 50-1302.

Respectfully Submitted,

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### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450

on 10/31/03 by Clare Fenny